

REMARKS

Reconsideration and allowance of this application are respectfully requested. Claims 4-5, 14-15, 24-25, 33-34 and 39 are cancelled. Claims 1-3, 6-13, 16-23, 26-32, 35-38 and 40-49 remain in this application and, as amended herein, are submitted for the Examiner's reconsideration.

Applicant expresses appreciation for the telephone interview held with Examiner Saltarelli on July 13, 2005 regarding the rejection of claim 1 over the cited references. The arguments presented in the present Amendment include the arguments discussed during the interview. No agreement was reached.

Claims 6-7, 9-10, 16-17, 19-20, 26-27, 29-30, 35-36 and 40-49 were amended to maintain proper antecedence and to remove language that was copied into the independent claims. No new matter is presented by these changes.

In the Office Action, the Examiner objected to claim 41 because of an informality and requested that claim 41 be amended to depend from claim 39 rather than from claim 37. Claim 39 is cancelled, and claim 37 has been amended to include limitations previously set out in claim 39. It is therefore submitted that claim 41 now properly depends from claim 37.

The Examiner also raised various art rejections:

I. Claims 1, 3, 11, 13, 21, 23, 31, 32, 37 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn (U.S. Patent No. 5,721,829) in view of Abecassis (U.S. Patent Application Publication No. 2001/0041053) and Sartain (U.S. Patent No. 5,914,712). It is submitted, however, that the claims are patentably distinguishable over the references.

The Dunn patent describes a centralized headend server that stores programs and which retrieves and transmits desired programs in response to user requests sent from a set-top box located in a subscriber home. To order a program, the user

selects the video-on-demand channel and actuates an icon on the screen that causes the set-top box to send a message to the headend. The message contains a descriptor of the program which the headend uses to access and retrieve the requested program. (See Figs. 1, 3 and 5; col. 3, lines 43-55; col. 4, lines 8-9 and 36-46; col. 5, lines 8-40; and col. 7, lines 20-42). As acknowledged by the Examiner, the patent does not disclose or suggest a user request in a freestyle text format and does not disclose or suggest converting a freestyle text format user request into a distribution request e-mail message that includes the user request and that is addressed to a distribution controller of a transmitter.

The Examiner relies on the Abecassis publication as teaching a free-form style user request for content-on-demand video programs that is analyzed by the video provider using, e.g., a keyword search and retrieval, and the Examiner relies on the Sartain patent as teaching a video-on-demand system wherein distribution requests are made via e-mail. Sartain, however, describes a system in which subscriber selections of video programs are relayed over the Internet to an accounting service using, e.g., an e-mail address. The e-mail message is addressed to the accounting service rather than being addressed to the office that sends the selected programs to the subscriber's television. (See Fig. 5; and col. 10, lines 15-20).

The Examiner nevertheless contends that there is no clear support in Sartain for saying that the accounting service is a separate entity from the distribution system and further argues that the external request gateway, described at col. 9, lines 42-59, stores customer account information and thus is an accounting service. However, as Fig. 5 shows, the external request gateway does not provide video programming. Rather, the external request gateway provides user supplied video selection and related information to the office which, in turn, delivers

the video programming to the user. Thus, even if the external request gateway is considered an accounting service, the e-mail message is addressed to the external request gateway and not to the office. It follows that Sartain does not disclose or suggest a distribution request e-mail message that is addressed to a distribution controller of a transmitter.

The Examiner also asserts that the combination of Dunn, Abecassis and Sartain does in fact meet the claimed limitation of addressing the e-mail address of the distribution controller as Dunn teaches receiving requests at the distribution controller and Sartain teaches receiving requests via e-mail. However, Dunn describes a request for a desired program that is sent to a headend that transmits the desired program, whereas Sartain describes a request e-mail that is sent to an accounting service rather than directly to the office that provides the video programming. A person of ordinary skill in the relevant art would not find a suggestion to modify Dunn, which teaches sending a subscriber request directly to the entity that transmits the desired program, from Sartain, which teaches transmitting a request e-mail to another entity, namely the accounting service.

Neither Dunn, Abecassis nor Sartain suggests:

said receiver being operable to accept a user request for a desired program, the user request being in a free style text format, to convert the user request into a distribution request e-mail message that includes the user request and that is addressed to a distribution controller of said transmitter, and to send the distribution request e-mail message to said transmitter

as recited in claim 1.

Claim 1 has also been amended to call for:

said distribution controller being operable to receive the distribution request e-mail message, to determine whether the requested program is one of the stored plurality of distributable programs, to

transmit an answer e-mail message to said receiver in response to the distribution request e-mail message, the answer e-mail message including a notice of correspondence and including supplemental information when the requested program is one of the stored plurality of distributable programs, the supplemental information including cryptanalytic information for decrypting the program, and to read out the requested program from said distributable program storing unit when the requested program is one of the stored plurality of distributable programs[.]

Neither Dunn, Abecassis nor Sartain discloses or suggests an answer e-mail message including supplemental information that includes *cryptanalytic information for decrypting a program*. Likewise, the Yurt, Venkatraman, and Lawler patents, which are also cited by the Examiner in the present Office Action, neither disclose nor suggest supplemental information that includes *cryptanalytic information for decrypting a program*.

Additionally, though the references could be considered to address similar problems, namely, how to carry out the selection and distribution of video programs, this similarity merely indicates that the references could be within the scope of the art considered by the ordinary practitioner under 35 U.S.C. § 103. See M.P.E.P. § 2141.01(a). The separate requirement of establishing motivation for the ordinary practitioner to combine the features taught by the references is not met here. Rather, each of the references merely provides an alternative solution to the problem. Dunn teaches the ordering of video programs using a user interface screen by which the user actuates an order icon to send a descriptor, Abecassis alternatively teaches ordering video programs using keyword searching and retrieval, and Sartain alternatively teaches the ordering of such program by a user sending a program identification number and a credit card number to an accounting service over the Internet through, e.g., an e-mail address. Even if the references were taken in combination, the

combination would only suggest that any of the above solutions would work by itself. Nothing in any of the references suggests that a beneficial result would come about by attempting to combine the bits and pieces of the references. The mere fact that the references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01.

The Examiner nevertheless contends that the motivation to combine the teachings of Dunn and Abecassis is the benefit of quickly finding desired titles using a keyword search. However, Abecassis provides a solution to the problem of ordering video programs and thus would provide no motivation to modify another reference that already addresses the same problem. Likewise, Dunn provides a solution to the problem of ordering video programs and thus there is no motivation to modify Dunn to attain a solution to the same problem. The Examiner further argues that the motivation to combine the teachings of Dunn and Sartain is the benefit of utilizing the Internet for making requests. Again, Sartain provides a solution to the problem of ordering video programs and thus would provide no motivation to modify another reference that already addresses the same problem, and Dunn likewise provides a solution to the problem of ordering video programs and thus there is no motivation to modify Dunn to attain a solution to the same problem. Moreover, even if such motivation were present, it would at best suggest to the ordinary practitioner to modify the teachings of Dunn to transmit a request generated in the manner described by Dunn over the Internet. The ordinary practitioner would not find motivation in either Dunn, Abecassis or Sartain to combine their teachings in the manner asserted by the Examiner. Therefore, the asserted combination of the references is not obvious.

It follows that neither Dunn, Abecassis nor Sartain, whether taken alone or in combination, discloses or suggests the

system called for in claim 1, and therefore claim 1 is patentably distinct and unobvious over the references.

Claim 3 depends from claim 1 and is distinguishable over the cited art for at least the same reason.

Claim 11 is directed to a method of distributing programs and includes limitations similar to those called for in claim 1. Claim 11 is therefore patentably distinct and unobvious over Dunn, Abecassis and Sartain at least for the same reasons.

Claim 13 depends from claim 11 and is distinguishable over the cited references for at least the same reasons.

Claim 21 defines a transmitter and includes limitations similar to those recited in claim 11 and is also patentably distinct and unobvious over Dunn, Abecassis and Sartain for at least the same reasons.

Claim 23 depends from claim 21 and is distinguishable over the references at least for the same reasons.

Claim 31 is directed to a receiver having a controller that is operable in a manner similar to the receiver defined in claim 1. Therefore, claim 31 is patentably distinct and unobvious over Dunn, Abecassis and Sartain at least for the same reasons.

Claim 32 depends from claim 31 and at least for the same reasons, is distinguishable over the cited art.

Claim 37 is directed to a method of receiving programs and calls for converting an e-mail message into a distribution request having limitations similar to those described above. Therefore, at least for the same reasons, claim 37 is also patentably distinct and unobvious over Dunn, Abecassis and Sartain.

Claim 38 depends from claim 37, and for at least the same reasons, is distinguishable over the references.

II. Claims 2, 12 and 22 were rejected under 35 U.S.C. § 103 as being unpatentable over Dunn, Abecassis and Sartain as applied to claims 1, 11 and 21 above and further in view of Yurt (U.S. Patent No. 5,550,863). It is submitted, however, that the claims are patentably distinguishable over the references.

Claim 2 depends from claim 1, claim 12 depends from claim 11, and claim 22 depends from claim 21. Therefore, claims 2, 12 and 22 are each distinguishable over Dunn, Abecassis and Sartain at least for the same reasons.

The Yurt patent describes an audio and video transmission system in which a user accesses an item in a source material library by (i) dialing a system access number and then entering the identification code of the item or (ii) logging onto a user interface and then providing an identification code, a title or other known facts of the item. (See Figs. 3 and 4; col. 11, lines 1-7; col. 13, lines 37-58; and col. 14, lines 34-51). Yurt does not remedy the above-described deficiencies of Dunn, Abecassis and Sartain regarding claims 1, 11 and 21.

III. Claims 5, 7, 15, 17, 25 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis and Sartain as applied to claims 1, 11 and 21 and further in view of Yurt and Venkatraman (U.S. Patent No. 6,477,647). Claims 5, 15 and 25 are cancelled. It is submitted that the remaining claims are patentably distinguishable over these references.

Claim 7 depends from claim 1, claim 17 depends from claim 11, and claim 27 depends from claim 21. Therefore, each of the claims is distinguishable over Dunn, Abecassis and Sartain for at least the same reasons. Additionally, Yurt does not address the deficiencies of these references at least for the reasons described above in response to the rejection of claims 2, 12 and 22.

The Venkatraman patent describes an on-line trading system where, after completing a trade, the customer may opt to receive a confirmation e-mail message. The customer can open and view the message, and when the customer closes the message, a return receipt is transmitted to the trading system. (See Figs. 3, 4 and 6; col. 2, line 64 - col. 3, line 10; col. 6, lines 8-23 and 39-54; and col. 7, line 27 - col. 8, line 18). Venkatraman therefore does not remedy the above-noted deficiencies of Dunn, Abecassis, Sartain and Yurt regarding claims 1, 11 and 21.

IV. Claims 6, 8, 16, 18, 26 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis, Sartain and Yurt as applied to claims 2, 12 and 22 and further in view of Venkatraman. It is submitted that the claims are patentably distinguishable over the cited art.

Claims 6 and 8 depend from claim 1, claims 16 and 18 depend from claim 11, and claims 26 and 28 depend from claim 22. Therefore, each of claims 6, 8, 16, 18, 26 and 28 are distinguishable over Dunn, Abecassis, Sartain, Yurt and Venkatraman for at least the same reasons set out above.

V. Claims 9-10, 19-20, 29-30 and 42-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis, Sartain, Yurt and Venkatraman as applied to claims 5-6, 15-16 and 25-26 and further in view of Lawler (U.S. Patent No. 5,805,763). It is submitted, however, that the claims are patentably distinguishable over the cited references.

Claims 9-10 and 42-43 depend from claim 1, claims 19-20 and 44-45 depend from claim 11, and claims 29-30 and 46-47 depend from claim 21. Therefore, each of claims 9-10, 19-20, 29-30 and 42-47 are distinguishable over Dunn, Abecassis, Sartain, Yurt and Venkatraman at least for the reasons described above regarding claims 1, 11 and 21.

The Lawler patent describes an interactive viewing system in which a user selects programs for display or for future recording. The programs are selected from a menu that is generated by an interactive station controller located at the user's station and shown on a display screen. The selection of a program causes the interactive station controller to either tune to the program, set a reminder tag, or set a record tag that may be stored locally or sent to a headend. (See Figs. 2, 4A-4B, 6 and 7; col. 7, lines 19-28; col. 8, lines 12-17; col. 10, lines 30-64; col. 11, lines 7-31; and col. 11, line 45 - col. 13, line 12). Lawler does not remedy the deficiencies of Dunn, Abecassis, Sartain, Yurt or Venkatraman regarding claims 1, 11 and 21 as described above.

VI. Claims 34 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis and Sartain as applied to claims 31 and 37 and further in view of Venkatraman. Claims 34 and 39 are cancelled.

VII. Claims 35 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis, Sartain and Venkatraman as applied to claims 34 and 39 and further in view of Yurt. It is submitted, however, that the claims are patentably distinguishable over the cited references.

Claim 35 depends from claim 31, and claim 40 depends from claim 37. Claims 35 and 40 are therefore distinguishable over Dunn, Abecassis, Sartain and Venkatraman for at least the reasons described above with regards to claims 31 and 37. Also, as noted above, claims 31 and 37 include similar limitations to those set out in claims 1, 11 and 21, and thus Yurt does not remedy these deficiencies at least for the same reasons.

VIII. Claims 36 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis and Sartain as applied to claims 31 and 37 and further in view of Lawler.

However, it is submitted that the claims are patentably distinguishable over the cited art.

Claim 36 depends from claim 31, and claim 41 depends from claim 37. Each of claims 36 and 41 are therefore distinguishable over Dunn, Abecassis and Sartain at least for the same reasons. Moreover, claims 31 and 37 include limitations similar to those of claims 1, 11 and 21, as described above, and therefore Lawler does not remedy these deficiencies at least for the same reasons.

IX. Claims 48 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis, Sartain and Lawler as applied to claims 36 and 41 and further in view of Yurt. However, it is submitted that the claims are patentably distinguishable over the references.

Claim 48 depends from claim 31 and claim 49 depends from claim 37. Therefore, claims 48 and 49 are each distinguishable over Dunn, Abecassis, Sartain, Lawler and Yurt for at least the reasons set out above.

Accordingly, the withdrawal of the rejections under 35 U.S.C. § 103 is respectfully requested.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which the Examiner might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Respectfully submitted,

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